

REMARKS/ARGUMENTS

Claims 1-24 are pending in this application, with claims 1, 13 and 24 being the only independent claims. Claim 24 is added. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1-23 stand rejected under 35 U.S.C. §103 as obvious over U.S. Patent No. 5,754,656 (Nishioka) in view of U.S. Patent No. 6,209,095 (Anderson).

The present invention relates to a method and system for effecting a payment transaction between a payer and a payee and more specifically to a method and system for digitally signing a form by a payer using a mobile station.

Independent claim 1 specifically recites “a payment machine” and “a mobile phone” and the steps “computing, in a payment machine, a first hash code for the material to be signed”, “digitally signing, using the mobile station, the material and the first hash code transferred to the mobile station” and “verifying, in the payment machine, the authenticity of the signed and transferred material by comparing the signed hash code with the first hash code computed from the material before signature”.

As stated in MPEP §2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. As described below, the third criteria has not been met by the current rejection of claims 1-23 because the combined teachings of Nishioka and Anderson fail to disclose, teach or suggest a payment machine that (1) generates a document that

is sent to the mobile station and computes a hash with the document, and (2) receives the signed document from the user and verifies the authenticity of the document by checking the signed hash.

The Office Action alleges that the user's smart card 20 disclosed by Nishioka is the claimed mobile station and that the user site apparatus 10 is the claimed payment machine. However, Nishioka fails to teach or suggest that the user site apparatus 10 authenticates the signature made by the smart card 20. Instead, Nishioka discloses that a retail store site apparatus 30 authenticates the signature (see col. 14, lines 18-23 of Nishioka). The user site apparatus 10 merely passes the signature onto the retail store site apparatus 30 (see col. 13, lines 41-47). This makes sense because the smart card 20 is inserted directly into the user site apparatus 10 and both the smart card 20 and user site apparatus 10 are under the control of the user. Thus, only the retail store site apparatus 30 operated by the payee has a need to verify that the signed information is correct so that the correct payment will be transferred for the goods or services provided by the payee. Since the user site apparatus 10 of Nishioka does not authenticate the signature, it can not be considered to be the claimed payment machine.

Anderson fails to teach or suggest what Nishioka lacks. Anderson discloses a signing method for computer-based document signing. According to Anderson, separate hashes are calculated for two sections of a document (see Fig. 35; and col. 20, lines 16-31 of Anderson). The hashed sections are placed consecutively in a message and a hash is calculated for the combined sections, which is signed. This ensures that no third party has tampered with any of the parts of the document, i.e., the final signature ensures the authenticity of the entire document. Furthermore, Anderson discloses that the payer 12 creates the financial instrument and signs it (see, e.g., col. 23, lines 41-45). And a payee receives and validates the signature (see col. 23, lines 57-60). Since the payer both creates and signs the document and a separate entity verifies

the signature, Anderson fails to teach or suggest “computing, in a payment machine, a first hash code for the material to be signed” and “verifying, in the payment machine, the authenticity of the signed and transferred material by comparing the signed hash code with the first hash code computed from the material before signature”, as expressly recited in independent claim 1.

Furthermore, there is no motivation, teaching or suggestion to modify the teachings of Nishioka and Anderson to meet the limitations of the claimed invention.

In view of the above remarks, the current rejection of independent claim 1 as obvious in view of Nishioka and Anderson does not establish a *prima facie* case of obviousness, and independent claim 1 is allowable over the prior art of record.

Independent claim 13 includes similar limitations. Accordingly, the current rejection of independent claim 13 also fails to establish a *prima facie* case of obviousness and independent claim 13 should be allowable for at least the same reasons as is independent claim 1.

Dependent claims 2-12 and 14-23 are allowable for the same reasons described above with respect to independent claims 1 and 13, as well as for the additional recitations contained therein.

Dependent claim 10 recites “the material or part of the material is presented *on the display in the mobile station* before the material is signed”. The Examiner previously referred to col. 13, lines 3-8 of Nishioka in the rejection of claim 10. However, this section of Nishioka describes the user site apparatus 10 which the Examiner considers to be the claimed payment machine. The smart card 20, which the Examiner considers to be the claimed mobile station, does not have a display. Accordingly, dependent claim 10 should be allowable for at least this additional reason.

Dependent claim 18 includes a limitation similar to that of claim 10, and should be allowable for the same reasons as is claim 10.

Claims 20-23 recite that the communication between the mobile station and the payment machine is by wireless transmission and, specifically, by Bluetooth or infrared technology. Support for these limitations is found at page 9, lines 5-10 of the original application.

The Office Action states that the user site apparatus 10 of Nishioka is considered to read on the claimed payment machine and the smart card 20 of Nishioka is the mobile station. However, these components do not communicate by wireless transmission. Accordingly, claims 20-23 are allowable for at least these additional reasons.

New claim 24 is similar to independent claim 1, but further recites that the form is “for a payment transaction between a payee and payer”, that the payment device is “a local payment device of the payee”, that the mobile station is “a mobile station of the payer”, and “the mobile station being configured for wireless communication in a wireless communication network”. Support for these features is found at page 1, lines 11-15, page 2, lines 23-32, page 7, lines 3-7, and page 9, lines 28-36 of the specification as originally filed.

In view of the above amendments and remarks, the application is now deemed to be in condition for allowance, and early notice to that effect is solicited.

The amount of \$50.00 is enclosed in payment for the addition of one new claim in excess of 20.

It is believed that no additional fees or charges are required at this time in connection with the present application. However, if any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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Dated: July 11, 2008